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In re Application of :
Jonathan A. R. Roffey et al :
Serial No.: 10/009,567 : PETITION DECISION
Filed: April 5, 2002 :
Attorney Docket No.: 040283-0196 :

This is in response to the renewed petition under 37 CFR 1.144, filed August 17, 2004, requesting withdrawal of an improper restriction requirement. The delay in acting on this petition is regretted, however it was only brought to the attention of the deciding official recently.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 and accepted on April 5, 2002, and, as amended, contained claims 1-14, 17-21, 24-26, and 28-29. In a first Office action, mailed June 6, 2003, the examiner held Lack of Unity between the claims, as follows:

Group I – Claims 1-14, 17-21, 24-26, and 28-29, where A is phenyl, drawn to a product, its method of preparation and use for treatment of obesity;

Group II – Claims 1-14, 17-21, 24-26, and 28-29, where A is phenyl, drawn to a product, its method of preparation and use for treatment of depression;

Group III – Claims 1-14, 17-21, 24-26, and 28-29, where A is tetrahydropyridinyl, drawn to a product, its method of preparation and use for treatment of obesity;

Group IV - Claims 1-14, 17-21, 24-26, and 28-29, where A is tetrahydropyridinyl, drawn to a product, its method of preparation and use for treatment of depression;

Group V - Claims 1-14, 17-21, 24-26, and 28-29, where A is 2,3-dihydro-1,4-dioxin, drawn to a product, its method of preparation and use for treatment of obesity; and

Group VI - Claims 1-14, 17-21, 24-26, and 28-29, where A is 2,3-dihydro-1,4-dioxin, drawn to a product, its method of preparation and use for treatment of depression.

The examiner also allowed applicants to define a different embodiment for A and elect it as not all possible embodiments for A were identified. The examiner held Lack of Unity based on lack of a common special technical feature in the ring system due to the variability of A.

Applicants replied on July 7, 2003, and defined A as 2,3-dihydrofuryl and elected it with traverse, setting forth appropriate arguments.

The examiner maintained the holding in the next Office action, mailed September 29, 2003, and examined and found allowable the embodiment elected by applicants. Claims 18-21 and 26 were withdrawn as drawn to a non-elected invention. An objection to the claims was also set forth in that they contained non-elected subject matter which needed to be canceled. The examiner also replied to the traversal of the Lack of Unity requirement.

Applicants amended the claims in a reply filed December 1, 2003, and added claims 31-36. Applicants again traversed the Lack of Unity requirement and presented the same arguments as previously in support thereof. The Lack of Unity holding was also petitioned.

On March 19, 2004, the examiner mailed a Final Office action to applicants making the Lack of Unity and objection to the claims Final for reasons previously set forth. A full reply to applicants' arguments regarding the Lack of Unity holding was also made.

A petition decision sustaining the examiner's position was mailed to applicants on June 17, 2004.

Applicants filed a Request to Reconsider the Petition Decision on August 17, 2004, and concurrently filed RCE papers which have been accepted, but not further acted on pending the petition decision. The RCE papers include an amendment limiting the A ring to a five membered ring optionally containing one heteroatom from O, S or N, all other variables remaining as previously defined.

DISCUSSION

Applicants request reconsideration only to a limited extent of the previous petition decision in view of the amendments to the claims. Having amended the claims with the amendment accompanying the RCE papers and limiting A to a five member ring optionally containing one heteroatom, applicants request that Unity be found with respect to the remaining claims in the application.

Applicants argue that since this application is the national stage entry of an International (PCT) application, PCT guidelines for holding of Lack of Unity must be followed and rely on two examples (Examples 19 and 20) from Annex B of the Administrative Instructions for PCT which are incorporated into the Rules of Practice. While the examples on their face appear to support applicants' argument for rejoinder, it must be remembered that the examples are illustrative only and rely on simple structures to establish a point.

The previous petition decision stated that the tricyclic indoline is not a fixed structure for two reasons, (1) it is a variable size ring (5 or 6 membered) and (2) it contains, optionally, a heteroatom of O, S or N, and gave examples thereof. By limiting the ring size in the continuing prosecution to five membered only, the first of these reasons has been rendered moot. However, the second reason, the presence of a variable heteroatom remains. It is well recognized in the art that the presence or absence of a heteroatom in a structure, especially a ring structure, alters its physical and chemical characteristics and reactivities. In other words, a structure with an N atom present in the A ring would be different in structure and activity from an A ring with no heteroatom or one with an O or S heteroatom. That an aminoethyl group also is part of the basic structure is noted, but it does not affect the characteristics of the tricyclic structure, especially the A ring which is opposite to the point of attachment of the aminoethyl group. In general a special technical feature based on structure requires that the structure be invariant, or if containing a variable, the variable values must be art recognized as equivalents in the structure.

With respect to the two examples cited from Annex B, both show an alkyl attached to a six membered heteroring having Z as a heteroatom (O, S, N or C). Note that the last sentence of each example states that the six membered heterocyclic ring would not have been sufficient to establish Unity absent some other teaching of equivalence. In like manner here, the bicyclic indoline ring structure (which here is the invariant structure) is not sufficient to establish Unity absent some additional qualifying structure or activity. Even with the aminoethyl group attached to the indoline ring Unity lacks as established by the examiner through citation of references showing such structure. Only with the addition of the A ring can Unity be established by creation of a special technical feature or structure. However the A ring is common to four (or more) different structures, as noted above. In consequence thereof Unity is lacking between a non-heterocyclic A ring and an A ring with a N atom or an A ring with either an S or O atom (S and O being considered general equivalents).

In summary, the examiner's holding of Lack of Unity is proper based on variations in the A ring between O or S and N or no heteroatom and further based on the type of condition being treated (depression, obesity, etc.). The filing of RCE papers does not affect the basic holding except to eliminate any six membered A ring variants.

DECISION

The petition upon careful reconsideration is **DENIED**.

The application will be forwarded to the examiner for further prosecution.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.



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